

Applicants regard as the invention for the reasons set forth on page 2 of the Office Action dated December 15, 2004. Specifically, the Examiner asserts that these claims recite improper alternative language (*i.e.*, selected from A, B, and C) and requests that Applicants use "or" alternative language (*i.e.*, A, B, or C) or standard Markush language (*i.e.*, selected from the group consisting of A, B, and C). The Examiner directs Applicants to M.P.E.P. § 2173.05(h) for a discussion of proper alternative claim language. Applicants respectfully disagree with the Examiner, and traverse this rejection for at least the following reasons.

The phrase "X selected from A, B, and C" is proper language and more accurately describes the claimed invention, *i.e.*, the composition may contain one or more X with each X independently selected from the group A, B, and C. For example, both Applicants' claim language and the Examiner's proposed change cover a composition of the invention that may contain: A; A and B; or two A's, two B's and a C, as well as all other permutations. Applicants' claim language is clearer, and the Examiner has shown no legal basis for requiring Applicants to change it.

The Examiner relies on M.P.E.P. § 2173.05(h) for a discussion of proper alternative claim language. However, Section 2173.05(h) merely recites examples of proper claim language which may be representative but are not exclusive. In fact, the U.S. Patent and Trademark Office (PTO) provided other representative examples of proper alternative claim language.

Specifically, Applicants respectfully direct the Examiner to another example of proper alternative claim language set forth in the M.P.E.P: "wherein R1 is methyl or

phenyl, X and Z are selected from oxygen (O) and sulfur (S)." See M.P.E.P.

Appendix AI, Example 20, pp. AI 66, rev. 2, May 2004.

The PTO has also published model claims utilizing Applicants' preferred claim language, *i.e.*, X selected from A, B, and C, in the *Training Materials For Examining Patent Applications with Respect to 35 U.S.C. Section 112, First Paragraph - Enablement Chemical/Biotechnical Applications*, which can be found at the following website address: [www.uspto.gov/web/offices/pac/dapp/1pecba.htm](http://www.uspto.gov/web/offices/pac/dapp/1pecba.htm). These PTO training materials contain examples that demonstrate what the PTO considers to be proper claim language.

Specifically, the PTO training materials further clarify that "X selected from A, B, and C" is proper claim language. Following the background case law, training materials, and discussion regarding enablement, the PTO provides Examiners with several example of what the PTO considers to be proper claim language. In particular, Example H, entitled "Endothelin Receptor Antagonists," provides a model claim with alternative claim language that reads "at least one hetero atom selected from N, S, and O," while Example J, entitled "Selectin-Mediated Cellular Adhesion" provides a model claim with alternative claim language that reads "wherein the substituent is selected from halogen, C<sub>1-4</sub> alkyl, trifluoromethyl, hydroxy, and C<sub>1-4</sub> alkoxy."

In light of the additional examples of proper alternative claim language provided by the PTO, it is clear that there is no reason for the Examiner to require Applicants to change the claim language of the pending claims. Accordingly, Applicants respectfully submit that this reason for rejection under 35 U.S.C. § 112, second paragraph, is in error, and request that the rejection be withdrawn.

**III. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: 

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